

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(s):	Jonathan D. Levine	CONF. NO.	2426
SERIAL NO.:	10/041,081	ART UNIT:	2178
FILING DATE:	January 7, 2002	EXAMINER:	Cesar B. Paula
TITLE:	SYSTEM HAVING A SINGLE, ROBUST, UNIVERSAL WORKFLOW FOR THE CREATION, PRINTING, AND BINDING OF HARDCOPY BOOKS, AND FOR THE ACCESSIBILITY AND DELIVERY OF ELECTRONIC BOOKS		
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Introduction

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. Reconsideration of the rejection of the claims is respectfully solicited in light of the following remarks.

II. Remarks

The Examiner has erred in failing to enter the amendment to claim 20, submitted in the response to final rejection filed August 22, 2007. Claim 20 is amended to

correct a word processing error discovered by Applicant. No new matter is submitted and the amendment renders claim 20 in better condition for appeal.

The Examiner has further erred in failing to enter the amendment to claim 1, submitted in the response to final rejection, filed August 22, 2007. The amendment to Claim 1 was presented to further clarify what is meant by "solution- independent intermediate format", devoid of said particulars unique to the "originating software, hardware, and operating system". This language removes the issues raised by the Examiner and is consistent with other claims and the specification as indicated below. No new matter is presented. Claims 1 and 20 stand rejected under 35USC 112. These rejections are traversed on the following grounds.

It is the nature of the system and method of this application, that an original book file be established as a starting point (page 1, line 24 to page 2, line 3). In the Background of Related Art section of this application, this starting point is referred to, as an "original" master book file, and, therefore, must be created, by an originator or original content provider. This is evident throughout the application. Please refer, for example, to page 2, line 6 and in particular block 104 of figure 4. The original master book file is stated to have software characteristics "designed for the particular needs of the content provider". This content provider constitutes the originator. A person skilled in the art would understand that such software characteristics would accurately include, "a digital structure and codes of an originating software, hardware, and operating system" and further that such digital structure and codes of an originating software, hardware, and operating system, may also include particulars "unique to the originating software, hardware, and operating system". It is these particulars that hinder the use of the original master book file by subsequent publishing entities. Applicant has further amended the claims for consistency and to avoid what appears to be confusion on the part of the Examiner with respect to the

clear meaning of the specification. It is submitted that the reference to "Administrator of the system" refers to the administrator of the system *of the original content provider*. Applicant submits that this amendment fully remedies the basis for the rejection based on 35USC112 and should have been entered to simplify the issues on appeal. Such amendments are properly entered under 37USC1.116.

The Examiner has erred in issuing a final rejection in this application. In rejecting the claims in the last office action of June 22, 2007, the examiner has cited, for the first time, the reference Dodge, as a basis for new obviousness rejections. The citation of this new reference was not necessitated by Applicant's prior amendments, but by the acknowledgement by the Examiner of the deficiencies of the reference Warmus. Accordingly, the issuing of a final rejection is improper under MPEP section 706.07(c).

Claims 1-3, 9-22, and 28-30 are rejected under 35 USC 103(a) based on the combined teaching of the reference Warmus (US Pat. No. 6,332,149) in view of the newly cited reference Dodge (US Pat. No. 5,655,130.) The combined teaching of Warmus and Dodge does not render Claims 1-3, 9-22, and 28-30 obvious because it fails to teach or otherwise suggest each and every limitation of the claims. It is well settled that in order to establish a prima facie case for obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. In particular the combined teaching fails to disclose or suggest the claimed features of independent claim 1, namely, steps b, c, and d of the claimed method. Equivalent language is contained in claim 20. The Examiner acknowledges that the reference Warmus fails to disclose step b of claim 1.

The Examiner continues to indicate that the files of Warmus start with an original file wherein "said original digital structure and codes includes particulars unique

to the needs of the originator". This is an assumption by the Examiner, as there is nothing in Warmus that states this. This is because the original digital structure is irrelevant to the purpose of Warmus. Warmus is directed only to textual content. This assumption is an effort by the Examiner to support the impression that Warmus is directed to solving a problem similar to the problem to which this application is directed. The assumption is not correct. The problem to which Warmus is directed is a page file problem dealing with textual content and treats the textual files on a page by page basis, whereas the solution of the subject invention relates to digital platform of the entire book file. Warmus results in the customization of individual pages of a book during printing of multiple copies. Please refer to column 11, lines 10-29 of Warmus. In the system of this invention, all of the pages are processed in the same manner, with respect to content, while the entire book file may be transferred and converted to accommodate solution, or platform, or device dependent needs of a particular publisher. The deficiencies of the teaching of Warmus are, therefore, greater than the Examiner indicates and these deficiencies are not remedied by the teaching of Dodge.

The Examiner has recently cited the reference Dodge. Dodge teaches that, by using object oriented information management methods, a document database may be partitioned into a number of encapsulated data elements, that are classified and tagged. The document database may then be filtered and formatted to form variation specific documents (see column 4, lines 8-29 and figure 2 of Dodge).

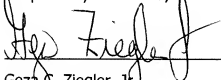
The document database is a compilation of documents suitable for different platforms. It, therefore, contains all of the software and digital codes of the originating content provider including any particulars unique to the originator and further includes all of the digital structures for other possible platforms (see column 6, lines 43-56). It does not convert an original, master book file into a

solution independent intermediate format, but instead creates a database in which elements of the book information are identified, tagged and classified to enable the compilation of different versions of the book file suitable for a particular platform. This is the opposite of the stripped down book file into which the master book file of this application is converted. The book file of Dodge is described at column 7, lines 21-32.

Dodge, therefore, fails to teach the elements of the claims identified above. Dodge fails to remedy the deficiencies of Warmus. The combined references do not therefore support a prima-facie case of obviousness. The modification of the teachings of Warmus and Dodge, in order to obtain the invention, as described in the claims submitted herein, would not have been obvious to one skilled in the art. Favorable reconsideration and allowance is respectfully requested.

The Commissioner is hereby authorized to charge payment for any -fees associated with this communication or credit any over payment to Deposit Account No. 24-0037.

Respectfully submitted,



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24 September 2007

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I hereby certify that this correspondence is being deposited transmitted electronically, on the date indicated below, addressed to the Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date: 24 September 2007

Signature: Shannon D'Amico
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